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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/734,424 | 12/12/2003 | Bernhard Sander | DT-6716 | 3920 |
| 30377 | 7590 | 06/23/2006 | EXAMINER | |
| DAVID TOREN, ESQ. ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017-5621 | | | GARCIA, ERNESTO | |
| | | ART UNIT | PAPER NUMBER | |
| | | | 3679 | |

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|----------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/734,424 | SANDER ET AL. | |
| | Examiner Ernesto Garcia | Art Unit 3679 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,7 and 8 is/are pending in the application.
 - 4a) Of the above claim(s) 3-6 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,7 and 8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 September 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/29/2005</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election of Species

Claims 3-6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 25, 2005.

Drawings

The drawings were received on September 29, 2005. These drawings are acceptable. However, a discrepancy exists between Figures 1 and 2.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "1" in Figures 1 and 2 has been used to designate both a coupling with a tool receptacle 2 having a first configuration and a coupling with a tool receptacle 2' having another configuration.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "contact tips (6) are spaced laterally apart forming at least one of said contact means (4a, 4b)" recited in claim 2, lines 2-3, lacks proper antecedent basis in the specification.

Claim Objections.

Claim 1 is objected to because of the following informalities:

regarding claim 1, this claim should be written in U.S. claim format since it is uncertain what the coupling is comprised of. Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 7, and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, the recitation "two oppositely directed contact means spaced from one another" in lines 3-4, has no support in the disclosure or the drawings.

According to Figure 1, the two contact means 4a and 4b are in contact and therefore not spaced from one another.

Regarding claims 2, 7, and 8, the claims depend from claim 1 and therefore do not comply with the written description.

Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 7, the metes and bounds of the claim are unclear. Applicants have not positively claimed the pre-stressing means in claim 1. It appears that applicants are intending to claim the pre-stressing means by further limiting the pre-stressing means, or if applicants are not claiming the pre-stressing means, how does claim 7 further limit the coupling. For purposes of examining claim 7, the examiner has considered the combination of the coupling and the pre-stressing means.

Regarding claim 8, the claim depends from claim 7 and therefore is indefinite.

Claim Rejections - 35 USC § 102

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Hembree et al., 6,045,026 (see marked-up attachment provided in the last Office action).

Regarding claim 1, Hembree et al. disclose, in Figure 2, a coupling between a tool receptacle **24** and a tool **14** with two oppositely directed contact means **20,A20** facing one another and spaced from one another. At least one of the contact means **A20** has a pointform **48**.

Applicants should note that the contact means **20,A20** are capable of being pre-stressed by a pre-stressing means.

Regarding claim 2, contact tips **52** are spaced laterally apart forming at least one of the contact means **20,A20**.

Claims 1, 2, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Aoki et al., 6,679,282 (see marked-up attachment provided in the last Office action).

Regarding claim 1, Aoki et al. disclose, in Figure 2, a coupling between a tool receptacle **1** and a tool **2** with two oppositely directed contact means **26,35** facing one

another and spaced from one another. At least one of the contact means **26,35** has a pointform contact tip **A4**.

Applicants should note that the contact means **26,35** are capable of being pre-stressed by a pre-stressing means.

Regarding claim 2, contact tips **52** are spaced laterally apart forming at least one of the contact means **26,35** (note column 12, lines 32-36, states more than one rib; therefore, inherently, the tips will be spaced laterally apart).

Regarding claim 7, Aoki et al. disclose the coupling in combination with a pre-stressing means **5,20,30**. The pre-stressing means **5,20,30**, comprises an axially directed screw-thread biasing member **5**.

Regarding claim 8, the screw-thread biasing member extends axially from the tool receptacle **1** into a threaded bore **20** extending axially into the tool **2**.

Response to Arguments

Applicants' arguments filed January 19, 2006 have been fully considered but they are not persuasive.

Applicants argue that Hembree et al. does not disclose “a coupling for transmitting ultrasound energy”. In response, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicants argue that the arrangement of Aoki et al. could not be used as a coupling for transmitting ultrasound energy. In response, applicants have not provided any evidence or support for indicating why the arrangement could not be used as a coupling for transmitting ultrasound energy. Further, applicants should note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicants remark that the “coupling” is separable after use and is not intended as a locked connection between the tool and the tool receptacle. The examiner has noted this remark and does not persuade to withdraw the rejection because according to one skilled in the art one reviewing Figure 1 suggests and shows a coupled connection thus a coupling. Note that the threaded connection by itself makes a coupling. Further, nothing in the language does it state that the claim is a listing of parts

or separable after use. In any event, the term coupling has being given its broadest reasonable interpretation.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. In particular, the new limitation "and spaced from one another" in claim 1, lines 3-4, necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kondo, 6,609,648, shows a similar a similar coupling.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-70837083. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and (571) 273-8300 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.G.
June 14, 2006

DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

